

Appendix D.
(PHOTOPRINT.)

*[For the Convenience of Court and Counsel this Appendix
(Photostatic Copy) is bound in on the Opposite Page.]*

Appendix D.

FIG. A

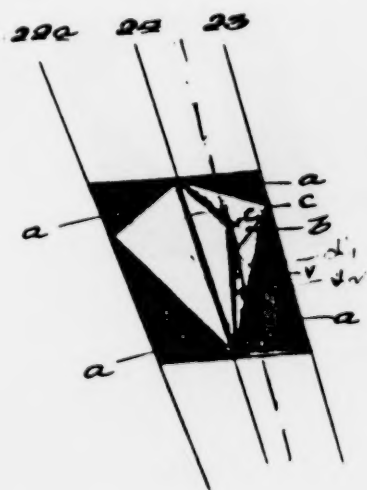


FIG. B



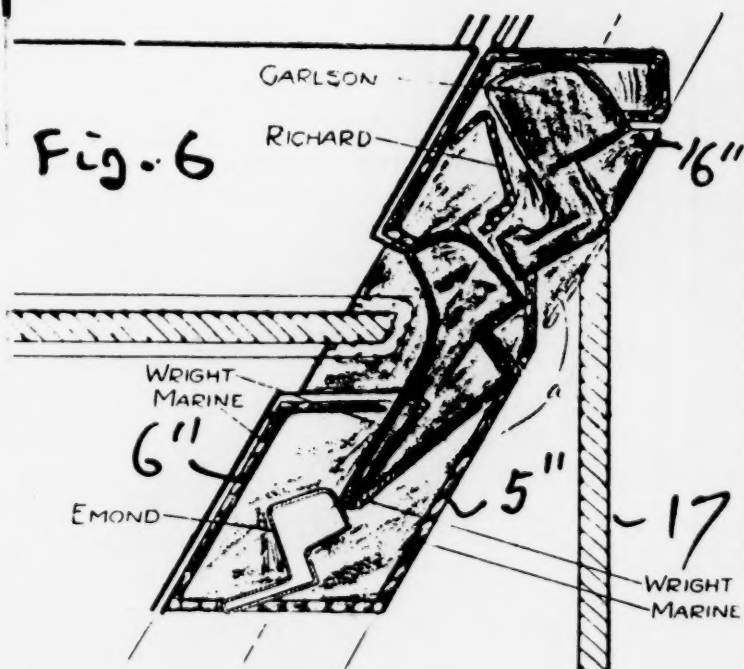


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IN THE
Supreme Court of the United States

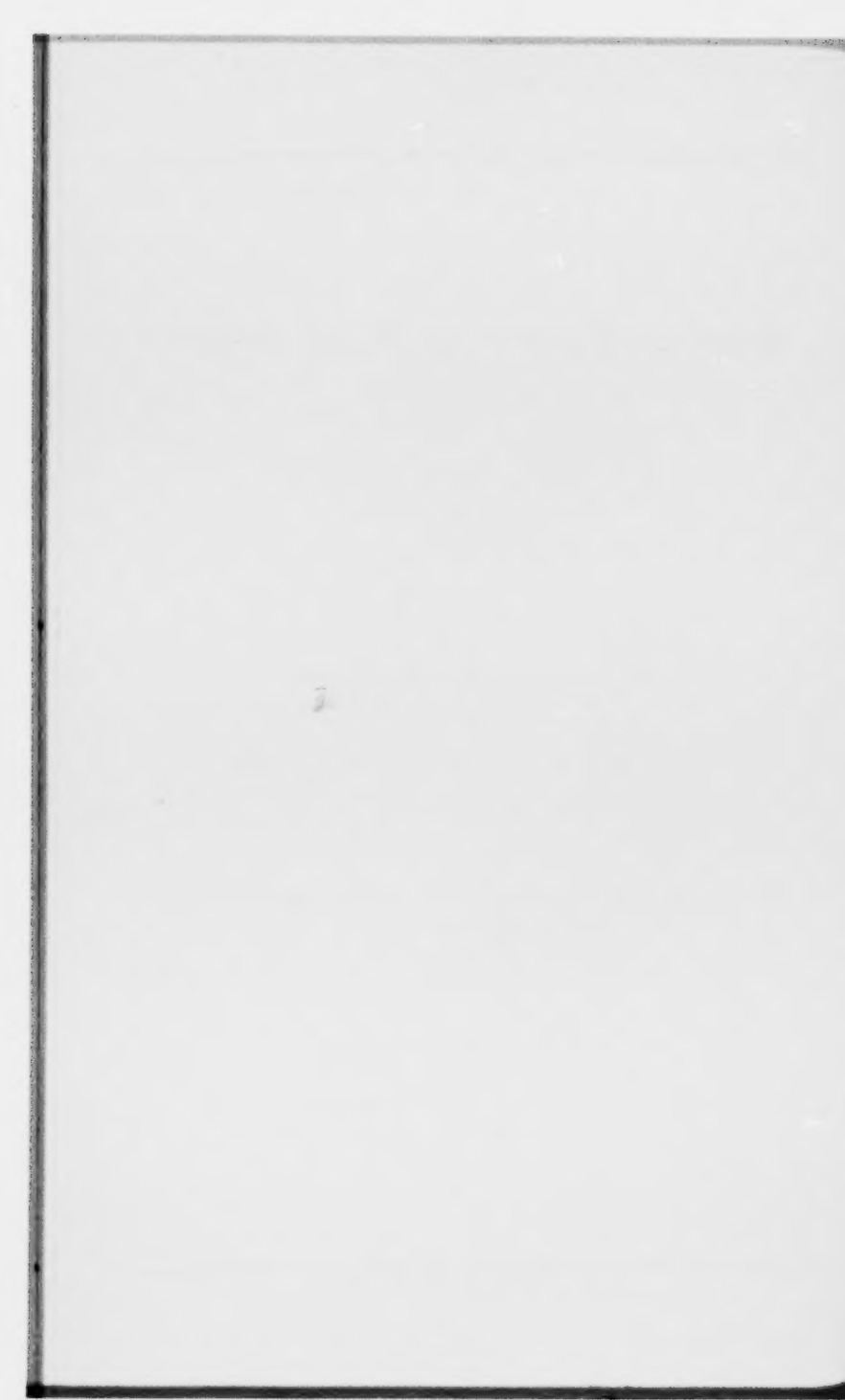
October Term, 1941.

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No. 1034.
—

RICHARD E. MARINE, *Petitioner*,
v.
CONWAY P. COE, COMMISSIONER OF PATENTS.

—
**PETITION FOR RECONSIDERATION OF PETITION
FOR CERTIORARI.**
—

RICHARD E. MARINE,
Pro Se.



INDEX.

SUBJECT INDEX.

	Page
Foreword	1
Test of Res Judicata of Lower Court Confiscatory of Property Rights	2
True Test of Res Judicata Established by Supreme Court	3
Lower Court's Test of Res Judicata Ignores other Principles Established by Supreme Court	4
New and Critical Evidence After Termination of Inter- ference Should Bar Res Judicata and Determine Case	5
Conclusion	6

TABLE OF CASES CITED.

Nesbit v. Riverside, 144 U. S. 610, 618	4
New Orleans v. Citizens Bank, 167 U. S. 371, 396-7 ...	4
Russell v. Place, 94 U. S. 606, 608	4
Southern Pacific Railroad v. United States, 168 U. S. 1, 48	3

STATUTES CITED.

R. S. 4886	3
R. S. 4888	3



IN THE
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October Term, 1941.

No. 1034.

RICHARD E. MARINE, *Petitioner*,

v.

CONWAY P. COE, COMMISSIONER OF PATENTS.

**PETITION FOR RECONSIDERATION OF PETITION
FOR CERTIORARI.**

To the Honorable the Chief Justice and the Associated Justices of the Supreme Court of the United States.

Your petitioner, Richard E. Marine, *pro se*, respectfully prays for reconsideration of the decision of this Honorable Court dated April 27, 1942 (— U. S. —) denying petitioner's petition for writ of certiorari to the United States Court of Appeals for the District of Columbia, and for the allowance of the writ requested in the aforesaid petition.

FOREWORD.

The dominating reason relied upon by petitioner for the grant of this petition for reconsideration is that the United

States Court of Appeals for the District of Columbia has announced a new test of *res judicata* in patent cases, after interference, destructive of the inherent and inalienable rights of a losing party to an interference to improvement inventions not disclosed by his successful opponent. In so doing the court has decided a question of law of broad public importance in direct conflict with all known authority, and has so far departed from the accepted and usual course of judicial procedure as to call for the exercise of this Court's power of supervision.

This has also led the court to refuse consideration of the true merits of petitioner's case and of controlling decisions of this Court relative thereto, including newly discovered evidence determinative of the entire merits of the case, which was not before the Patent Office and which has never been passed upon by any tribunal (*PB, bottom p. 11 to bottom p. 12).

TEST OF RES JUDICATA OF LOWER COURT CONFISCATORY OF PROPERTY RIGHTS.

The test of *res judicata* stated by the court below is paraphrased in petitioner's question 1 (PB 18) and is as follows (R 110):

"It is considered that this interference count reads on the structure disclosed in plaintiff's claims Nos. 5 and 57, and it would, therefore, seem that such claims are disposed of adversely to the plaintiff by that litigation."

This test in effect declares that a generic claim lost by an applicant to an opponent in interference would bar claims to the applicant for a species or improvement disclosed by him but not disclosed by his opponent. This would follow because the generic claim of the interference would read on both cases.

* Petitioner's main brief.

Res judicata cannot thus create a new statutory bar to patentability but must rest upon anticipation by actual disclosure in the opponent's case. It can create no bar more than can a prior patent, and the statutes (R. S. 4886 and 4888, PB 35), which provide for the grant of improvement patents, are abrogated by the test announced by the Court.

Reference to Fig. A, Appendix D, page 14, of petitioner's reply brief, shows that the white area, representing the cross-sectional area of Wright's Fig. 2, solely relied upon by respondent to anticipate petitioner's appealed claims 5 and 57, is much weaker than the white, gray and black areas, representing the total area and strength of petitioner assembly, (PRB 10 and 11). Even disregarding the lack of utility admitted by Wright for his Fig. 2 construction (PB 12) it is obvious that petitioner's improvement is more inventive than Wright's Fig. 2 step backward, and therefore the latter can not be res judicata as to the former.

TRUE TEST OF RES JUDICATA ESTABLISHED BY SUPREME COURT.

The test of res judicata, or estoppel by former judgment, herein adopted by the courts below is inconsistent with that established by the decisions of this Court. In *Southern Pacific Railroad v. United States*, 168 U. S. 1, 48, this Court said:

"The general principle announced in numerous cases is that a right, question or fact distinctly put in issue and directly determined by a court of competent jurisdiction, as a ground of recovery, cannot be disputed in a subsequent suit between the same parties or their privies; and even if the second suit is for a different cause of action, the right, question or fact once so determined must, between the same parties or their privies, be taken as conclusively established, so long as the judgment in the first suit remains unmodified."

To the same effect are the decisions of this Court in *Russel v. Place*, 94 U. S. 606, 608; *Nesbit v. Riverside*, 144 U. S.

610, 618, and *New Orleans v. Citizens' Bank*, 167 U. S. 371, 396-7. In *Russel v. Place* two claims of the same patent were held to constitute two different causes of action.

Applying this test to appealed claims 5 and 57 which are predicated upon the saving of the waste spaces, shown by the black areas, on one side of the assembly by effecting true alignment between the outer side of such areas and, say, the line of vision 23, it is apparent that the question of their patentability is not *res judicata* by reason of the "substantial" alignment between the right hand face of the white area representing Wright's erroneous Fig. 2, and the dotted line of vision through its apex c, which was the subject matter of the count awarded to Wright in Interference No. 61642.

LOWER COURT'S TEST OF RES JUDICATA IGNORES OTHER PRINCIPLES ESTABLISHED BY SUPREME COURT.

It also follows that the lower court erred (R 110) in "laying aside" the "geometry" of Wright's erroneous (PB 9, last par.) Fig. 2. Likewise it erred in holding that the "reasoning employed by the Court of Customs and Patent Appeals" compelled the holding of *res judicata* here (PB 14).

The danger inherent in the test of *res judicata*, for the first time laid down by the lower court, cannot be unduly emphasized. Even the established tests of *res judicata*, as applied in office practice, has great potentiality for injury to a meritorious inventor, after interference with a less meritorious opponent who is awarded priority on the basis of hyper-technical rules of construction of claims (PB 18, 19, Qs. 2 to 5), already condemned by this Court (PB 20 to 22).

It frequently occurs that the successful party to an interference obtains claims which he might not have obtained had the interference never existed and, conversely, due to the harsh and technical application of the principle of *res judicata*, the losing party obtains with great difficulty, if at all, protection of his legitimate property rights which would

not have been denied him had his opponent's case been prior art and no interference had ever existed. No logical reason exists for this result, which is doubtless due, in part, to the reluctance of the examiner, on *ex parte* action on new claims submitted by the losing party after the interference, to risk an interpretation of the decisions rendered in the interference by higher tribunals. On *ex parte* appeals thereafter the appellate tribunals frequently affirm on the theory of concurrent decisions. That these hyper-technical rules of procedure should be discouraged is the firm conviction of petitioner, based in part upon three years' experience in the Interference Division and seven years on the Board of Appeals of the Patent Office (R 47).

NEW AND CRITICAL EVIDENCE AFTER TERMINATION OF INTERFERENCE SHOULD BAR RES JUDICATA AND DETERMINE CASE.

The instant suit was an original action under R. S. 4915, and we submit, should have been decided by the lower court on the entire record, and especially so in the light of newly discovered evidence in the nature of an admission by Wright in his application record made after termination of Interference No. 61642 and therefore not available to petitioner during the progress of Interference No. 61642.

It is submitted that this admission is determinative of all the issues in the case (PB 10-12).

CONCLUSION.

For the reasons stated, it is submitted that the petition for rehearing should be granted and that the decision of the court below should be reviewed and reversed, and that a writ of certiorari should be granted to that end.

Respectfully,

RICHARD E. MARINE,
Pro Se.

May 22, 1942.

I hereby certify that the foregoing petition is presented in good faith and not for purpose of delay.

RICHARD E. MARINE.

End

